

The opinion in support of the decision being entered today was **not** written for publication and is **not** binding precedent of the Board.

Paper No. 29

UNITED STATES PATENT AND TRADEMARK OFFICE

---

BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

---

**Ex parte** JOSEPHINE MIU CHENG, JYH-HERNG CHOW,  
THANH TAN PHAM, HONGHAI SHEN, and  
I-SHIN ANDY WANG

---

Appeal No. 2004-0663  
Application No. 09/375,260

---

ON BRIEF

---

Before KRASS, BARRETT, and DIXON, **Administrative Patent Judges**.  
DIXON, **Administrative Patent Judge**.

**DECISION ON APPEAL**

This is a decision on appeal from the examiner's final rejection of claims 1-42,  
which are all of the claims pending in this application.

We REVERSE.

## **BACKGROUND**

Appellants' invention relates to a modification system for supporting localized data changes in a mobile device. An understanding of the invention can be derived from a reading of exemplary claim 1, which is reproduced below.

1. A method of localizing changes in a computer, the method comprising:

executing a change to data in a computer having a local database, the change being performed by the computer to modify data in the local database stored within a data storage device at the computer;

indicating, on the computer, whether the change is a global change or a local change; and

when the local database on the computer is synchronized with a main database on another computer, transmitting only global changes from the local database to the main database and not transmitting local changes.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Boothby	6,141,664	Oct. 31, 2000 (Filed Nov. 13, 1996)
Mendez	6,151,606	Nov. 21, 2000 (Filed Jan.16, 1998)

Claims 1-42 stand rejected under 35 U.S.C. § 112, second paragraph, as failing to particularly point out and distinctly claim the invention. Claims 1, 2, 15, 16, 29, and 30 stand rejected under 35 U.S.C. § 102 as being anticipated by Mendez. Claims 3-14,

17-28, and 31-42 stand rejected under 35 U.S.C. § 103 as being unpatentable over Mendez in view of Boothby.

Rather than reiterate the conflicting viewpoints advanced by the examiner and appellants regarding the above-noted rejections, we make reference to the examiner's answer (Paper No. 25, mailed Sep. 29, 2003) for the examiner's reasoning in support of the rejections, and to appellants' supplemental brief (Paper No. 24, filed Aug. 25, 2003) and reply brief (Paper No. 26, filed Dec. 1, 2003) for appellants' arguments thereagainst.

### **OPINION**

In reaching our decision in this appeal, we have given careful consideration to appellants' specification and claims, to the applied prior art references, and to the respective positions articulated by appellants and the examiner. As a consequence of our review, we make the determinations which follow.

#### **35 U.S.C. § 112, SECOND PARAGRAPH**

The examiner questions appellants use of the language "indicating, on the computer . . ." in independent claim 1. We are unclear as to the specific reason the examiner finds difficulty with appellants' usage of the above language. From our review of the instant claim language, we find no problem which rises to the level of rejection under 35 U.S.C. § 112, second paragraph. While the examiner may believe that the language may be better stated as "indicating, in the computer" it would appear that the

present language may be broader so as to encompass both a display and a storage rather than just a storage of the indication. Since we find no lack of particularity in the instant claim language, we will not sustain the rejection.

**35 U.S.C. § 102**

Initially we note that anticipation by a prior art reference does not require either the inventive concept of the claimed subject matter or the recognition of inherent properties that may be possessed by the prior art reference. **See Verdegaal Bros. Inc. v. Union Oil Co.**, 814 F.2d 628, 633, 2 USPQ2d 1051, 1054 (Fed. Cir.), **cert. denied**, 484 U.S. 827 (1987). A prior art reference anticipates the subject matter of a claim when the reference discloses every feature of the claimed invention, either explicitly or inherently. **See Hazani v. Int'l Trade Comm'n**, 126 F.3d 1473, 1477, 44 USPQ2d 1358, 1361 (Fed. Cir. 1997) and **RCA Corp. v. Applied Digital Data Systems, Inc.**, 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir. 1984). However, the law of anticipation does not require that the reference teach what the appellants are claiming, but only that the claims on appeal "read on" something disclosed in the reference. **See Kalman v. Kimberly-Clark Corp.**, 713 F.2d 760, 772, 218 USPQ 781, 789 (Fed. Cir. 1983), **cert. denied**, 465 U.S. 1026 (1984).

Further, as pointed out by our reviewing court, we must first determine the scope of the claim. "[T]he name of the game is the claim." **In re Hiniker Co.**, 150 F.3d 1362, 1369, 47 USPQ2d 1523, 1529 (Fed. Cir. 1998). Therefore, we look to the

limitations set forth in independent claim 1. Claim 1 recites “indicating, on the computer, whether the change is a global change or a local change; and when the local database on the computer is synchronized with a main database on another computer, transmitting only global changes from the local database to the main database and not transmitting local changes.” Appellants argue that Mendez does not teach indicating whether a change is a global or local change and using this indication as a condition to transmitting the change to a main database. (See brief at page 7.) Appellants argue that while Mendez teaches local and global computers, all of the change data are transmitted and there is no indication of a local change which is not transmitted at the time of synchronization. (See brief at page 7.) We agree with appellants. From our review of the teachings of Mendez identified by the examiner, we find no clear or implicit teaching of the claimed indication of local changes or global changes and use thereof in the transmission to a main database. The examiner maintains that columns 1, 2, 8, 9, 11 and 12 of Mendez support transmission of global changes. Additionally, the examiner contends that Mendez transmits less data by only transmitting the changes. (See final rejection pages 3-4, and answer at pages 4-5.) While we agree that Mendez is similar in transmitting only change data, we find no teaching that Mendez selectively transmits less than all of the change data. Therefore, the examiner has not shown that Mendez teaches all of the claimed limitations, and has not established a *prima facie*

case of anticipation. Therefore, we cannot sustain the rejection of independent claims 1, 15, and 29 and their dependent claims.

### **OBVIOUSNESS**

The examiner adds Boothby in combination with Mendez as evidence of the obviousness of the dependent claims. The examiner has not identified how Boothby remedies the deficiency in Mendez and, from those portions of Boothby cited by the examiner, we find no teaching or suggestion of the obviousness of the claimed invention. Therefore, we find that the examiner has not established a ***prima facie*** case of obviousness of the invention as claimed. Therefore, we cannot sustain the rejection of dependent claims 3-14, 17-28, and 31-42.

### **CONCLUSION**

To summarize, the decision of the examiner to reject claims 1-42 under 35 U.S.C. § 112, second paragraph is reversed, the decision of the examiner to reject claims 1, 2, 15, 16, 29, and 30 under 35 U.S.C. § 102 is reversed, and the decision of the examiner to reject claims 3-14, 17-28, and 31-42 under 35 U.S.C. § 103 is reversed.

### **REVERSED**

ERROL A. KRASS	)	
Administrative Patent Judge	)	
	)	
	)	
	)	
	)	
LEE E. BARRETT	)	BOARD OF PATENT
Administrative Patent Judge	)	APPEALS
	)	AND
	)	INTERFERENCES
	)	
	)	
JOSEPH L. DIXON	)	
Administrative Patent Judge	)	

JD/RWK

Appeal No. 2004-0663  
Application No. 09/375,260

GATES & COOPER LLP.  
HOWARD HUGHES CENTER  
6701 CENTER DRIVE WEST  
SUITE 1050  
LOS ANGELES, CA 90045